

Remarks/Arguments

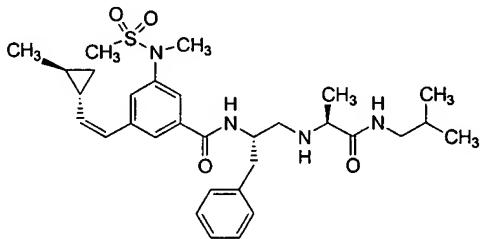
Entry of the foregoing amendments, and reconsideration of this application, as amended, is respectfully requested.

I. Status of the Claims

Claims 1-12 are pending. Claim 1 is amended to delete hydrogen from the possible R² groups. Claim 5 is amended to correct an error in the numbering of the R⁴ and R⁵ groups. Claims 13-15 are cancelled.

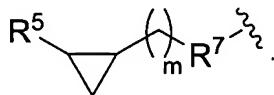
II. Species Election Requirement

In the Office Action, the Examiner required election of one species for prosecution in the event that no generic claim is allowed. As noted at page 3 of the office action, applicants had previously elected compound 20:



in a telephone conference with the Examiner. Applicants now confirm the election of compound 20.

Claims 1, 2, 3, 5 and 7-14 read on compound 20. Claim 1 reads on compound 20 when R⁹ is hydrogen; R¹⁰ is isobutyl; R² is R⁴-S(O)_pN(R⁵) wherein R⁴ and R⁵ are methyl and p is 2; and R³ is



wherein R⁷ is -CH=CH-, m is 1 and R⁵ is methyl.

II. Rejections Under 35 U.S.C. 112, First Paragraph

Method of treatment claims 13-15 stand rejected as lacking enablement. The Examiner states that "[t]he claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention." The Examiner also states that "[u]ndue experimentation would be required to determine which of applicants' compounds are most useful in treating Alzheimer's or the many diseases which could be embraced by inhibiting beta secretase."

Applicants respectfully disagree with the Examiner's assertion that claims 13-15 are not enabled. Nevertheless, in order to advance prosecution, claims 13-15 are canceled, thereby obviating the rejection. It is respectfully requested that the rejection be withdrawn.

Applicants reserve the right to pursue the subject matter of claims 13-15 in a continuing application.

III. Rejections Under 35 U.S.C. § 103

Claims 1-15 stand rejected as obvious over U.S. Pat. No. 6,962,934, to Warpehoski. The Examiner states that the claimed compounds overlap with Warpehoski when R¹ of the claims is R'100, of Warpehoski (see col. 3, l. 16-48); R⁵, R⁶ and R⁷ of Warpehoski are hydrogen; R⁴ of Warpehoski is optionally substituted alkyl; and R² of Warpehoski is aralkyl. The Examiner also states that Warpehoski discloses "close compounds," and identifies N-[(2S)-3-(3,5-difluorophenyl)-2-({3-[(dipropylamino)carbonyl]-5-methylbenzoyl}amino)propyl]-L-alanyl-N-(2-methylpropyl)-L-valinamide (Example 2).

In response, independent claim 1 is amended to delete hydrogen from the potential R² groups. None of the exemplified compounds in Warpehoski contain a substitution pattern in which R² is one of the substituents (2)-(7) as recited in claim 1. Further, there is no suggestion in Warpehoski to (1) select the compound cited by the Examiner (Example 2) from all the subject matter disclosed in Warpehoski, and (2) to modify the Example 2 compound by replacing the hydrogen at the R² position by one of the R² groups recited in the amended claims. Hence, the claimed compounds are not obvious over Warpehoski.

Claims 13-15 are canceled.

In view of the action taken and arguments made, it is believed that the obviousness rejections of claims 1-12 have been overcome, and it is respectfully requested that the rejections be withdrawn.

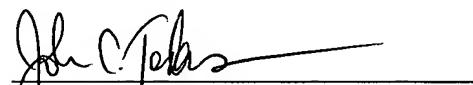
IV. Conclusion

In view of the foregoing, all pending claims 1-12 are not obvious over the cited art. Claims 1-12 are now in condition for allowance.

Favorable action is earnestly solicited.

Respectfully submitted,

By


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